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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,360	12/22/1999	KIMBERLY ANN HORAN	C-7197	6049

7590

05/28/2003

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 05/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/470,360

Applicant(s)

HORAN ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 13 May 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see pages 2-3.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 6-11.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

The remarks have been considered, but have not been persuasive.

The rejection of Claims 6-11 under 35 U.S.C. 103(a) as being unpatentable over Papa et al (U.S. 5,231,222) in view of Spiske et al (U.S. 5,248,427) is maintained as they were applied in the final rejection mailed 12-11-2002.

With respect to Papa's failure to teach recovering an organic phase from the first distillation and the Papa's organic phase from the second distillation as a reactant routed to the reaction zone, the Examiner has noted applicants' arguments. However, on the contrary to the applicants' assertion, the Papa does indicate that an ester composition containing ester, alcohol, and water may be removed from the first distillation column (see col. 9, lines 19-22); also, there is a teaching that the Papa's organic phase from the second distillation has been produced as a refined ester product, not as a reactant routed to the reaction zone (see col. 9, lines 26-30).

Therefore, the reference is relevant to the claimed invention.

Regarding the claimed process in which ethyl acetate is recovered from the first distillation and then directed to the reaction zone as an azeotroping agent, not a reactant for esterification, the Examiner has noted applicants' arguments. However, according to the Papa process, the esterification process produces both the ester and water distilled from the reactor and conveyed to a distillation column wherein aqueous azeotropes are formed (see col. 6, lines 63-67). Furthermore, in view of reviewing the passages from line 5 to 11 in the applicants' specification, tower 2 has been used as both the reaction zone and distillation zone. Therefore,

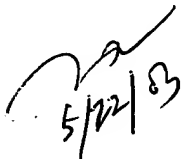
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there is no clear patentable distinction between the prior art reference and the current invention;
but the only difference in a mechanical expediency.

The arguments after final rejection have been fully treated, but will not overcome the rejection as stated above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Victor Oh whose telephone number is (703) 305-0809. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.


5/12/03



ALAN L. ROTMAN
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